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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/650,027	08/27/2003	Fred H. Burbank	R0367.00302	6463

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EXAMINER

SZMAL, BRIAN SCOTT

ART UNIT	PAPER NUMBER
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3736

DATE MAILED: 08/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/650,027

Applicant(s)

BURBANK ET AL.

Examiner

Brian Szmaj

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2006.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-30, 32, 33, 35-54 and 56-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 28-30, 32, 33, 35-47 and 58-62 is/are allowed.
- 6) ☒ Claim(s) 48 is/are rejected.
- 7) ☒ Claim(s) 49-54, 56, 57, 63 and 64 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6-22-06
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Claim Objections

1. Claim 48 is objected to because of the following informalities: In lines 15-16, "at least one transverse dimension" should read as "the transverse dimension", due to the previous disclosure of the tissue cutting element having a transverse dimension in lines 5-7 of the claim. Appropriate correction is required.
2. Claim 63 is objected to because of the following informalities: In line 15, "greater than a diameter" should read as "greater than a diameter". Furthermore, in lines 15-16, it is unclear to the Examiner if "the electrosurgical cutting element" should read as "the cannula" or "the stylet", since the current claim language reads as "an electrosurgical cutting element...which has an outer diameter that is greater (than) a diameter of the electrosurgical cutting element". Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claim 48 is rejected under 35 U.S.C. 102(e) as being anticipated by Bryan et al (6,050,955).

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Bryan et al. teach a biopsy apparatus including an elongate cannula (24) having a longitudinal axis, an open distal end, a proximal end, an inner lumen extending to and in fluid communication with the open distal end and a longitudinal axis; a first tissue cutting element (50) disposed on the open distal end of the cannula lying in a plane traversing the longitudinal axis of the cannula and having a transverse dimension; an elongate stylet (16) which is slidably disposed in part within the inner lumen of the cannula, which is configured for axial translation between a withdrawn position and an extended position and which has a distal end (13) configured (at 52) to receive the first tissue cutting element; and a second tissue cutting element (see at least Figures 3, 6, 12, 14 and 15) which is disposed on a distal end (13) of the stylet distal to the first tissue cutting element and which lies in a plane parallel with the longitudinal axis of said stylet and which has a cutting surface with at least one transverse dimension (measured from one side of the stylet head at the base of the cutting edge distally to the distal tip and proximally to a the base of the cutting edges at a diametrically opposite side of the stylet head) which is larger than at least one transverse dimension of the first tissue cutting element (see Figure 12).

Allowable Subject Matter

5. Claims 49-54, 56 and 57 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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6. Claim 64 is objected to as being dependent upon an objected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. The following is a statement of reasons for the indication of allowable subject matter: Claims 28-30, 32, 33, 35-38, 40-47 and 58-62 remain allowable as set forth in the Office Actions mailed on October 11, 2005 and April 12, 2006.

Response to Arguments

8. Applicant's arguments filed July 17, 2006 have been fully considered but they are not persuasive. Regarding the rejection of claim 48 under 35 U.S.C. 102(e) as being anticipated by Bryan et al, Applicant contends that Bryant et al. do not teach or suggest a second tissue cutting member with a cutting surface having at least one transverse dimension which is larger than at least one transverse dimension of the first tissue cutting element. Applicant further contends that the cutting surfaces of the device described in the Bryan et al. reference are smaller in transverse dimensions than the first cutting member. The Examiner respectfully disagrees. The claim language does not require that the transverse dimension of cutting surface be measured strictly as perpendicular with respect to the longitudinal axis of the stylet or cannula. Broadly interpreted, the limitation of a "transverse dimension" only requires a dimension that crosses the longitudinal axis. Therefore, the length of the cutting surface, as illustrated in Figure 12 of the Bryan et al. reference, when measured from one side of the stylet head at the base of the cutting edge distally to the distal tip and proximally to the base

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of the cutting edge at a diametrically opposite side of the stylet head can be considered to be a transverse dimension which is larger than the transverse dimension (measured as perpendicular to the longitudinal axis) of the first tissue cutting element. In view of the foregoing, the rejection of claim 48 under 35 U.S.C. 102(e) as being anticipated by Bryan et al. is maintained. In order to overcome the rejection, the claim language should explicitly disclose the transverse dimension is measured with respect to the longitudinal axis of the cannula or stylet.

Conclusion

9. This is an RCE of applicant's earlier Application No. 10/650,027. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Szmalec whose telephone number is (571) 272-4733. The examiner can normally be reached on Monday-Thursday, with Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571) 272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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